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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,547	10/30/2001	William L. Hergenrother	P01038US1A (P292)	8569

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Chief Intellectual Property Counsel
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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,547	Applicant(s) HERGENROTHER ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1203</u> . | 6) <input type="checkbox"/> Other: _____ |

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All remaining rejections and/or objections follow.

The amendment filed 1-29-03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: That thiazoles may be used in the instant invention.

Applicant is required to cancel the new matter in the response to this Office action.

The amendment filed 1-7-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The structure newly introduced at page 10 lines 8-21.

Applicant is required to cancel the new matter in the response to this Office action.

Claims 3, 5, 8, 9, 12, 14, 17, 19 and 20 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. The specification as filed does not disclose that thiazoles may be used in the instant invention. Nor does the specification as filed disclose the structures of claims 3, 8, 12, 17 and 20. These limitations are therefore new matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yatsuyanagi et al. (USP 6,518,367).

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See the Office action of 4-10-03 at the last complete paragraph on page 4.

Claims 15-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yatsuyanagi et al., cited above.

See the Office action of 4-10-03 at the last complete paragraph thereof.

Claims 1-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wolper (USP 3,781,250).

Wolper et al. disclose a rubber composition containing applicants' difunctional cross-linking agent wherein applicants' group Y is equal to hydrogen and n is equal to 1 in each case and containing a rubber and accelerator. Note column 2 lines 10-60 as well as Example 1 in this regard.

Applicants' arguments filed 1-5-04 have been fully considered but they are not deemed to be persuasive.

Applicants argue that support for their amendment is "evident" from U.S. Patent 3,781,250 as well as the Thiokol literature submitted. However, applicants have not pointed out where they have incorporated by reference the U.S. patent for the Thiokol literature in their specification as filed and even if such a disclosure was present in the specification as filed, the genus of the amended claims is broader than that disclosed by the

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Thiokol literature as well as the U.S. Patent 3,781,250 for at least the reason that the structure with $n =$ to 2-60 is not disclosed in either document.

With regard to the rejection under 35 U.S.C. § 112 first paragraph regarding "thiazoles", applicants argue that "the use of thiazoles was not omitted" and that applicants' "specification disclosed both CBS and MBTS, which are thiazoles". While it is true that applicants' specification discloses these two specific thiazoles, a genus is not enabled by disclosure of a single species. The fact that the genus is not the point of novelty is immaterial. With regard to the fact that applicants' claims as filed recited the use of "at least one accelerator" and that the term "accelerator" embraces "thiazoles", a subgenus of "accelerator", does not provide support for a specific subgenus, i.e. in the instant case the term "accelerator" does not provide support for the specific subgenus thiazoles.

With regard to the rejection under 35 U.S.C. § 102(e) relying on Yatsuyanagi et al. '367, applicants argue that the generic structure shown in the structure of the patent is not embraced by the generic structure of applicants' claims. The Examiner does not agree with this since the R^1 group of patentees could conceivably embrace organic groups such as those terminated

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by sulfur. Note that Table II at column 21 lines 13-16 of the patent discloses the use of Thiokol LP-31, as does applicants' specification. Patentees of course further react the Thiokol material with a reagent for terminating the Thiokol reagent but applicants' group "alkaryl" embraces such groups. There is nothing contradictory regarding the disclosure of the specific example at column 21 lines 13-16 of the patent with the Abstract of the patent given that the Abstract of the patent merely discloses that the R¹ group is "an organic group". Applicants' argument presupposes that the organic group is necessarily a group such as alkyl but there is nothing in the patent indicating that patentees envision such a narrow definition.

With regard to applicants' arguments regarding the restriction requirement, it is true that the paragraph referred to in MPEP § 803.02 recites the term "unity of invention". However with regard to the term "unity of invention", it appears to the Examiner that this term is used in connection with applications filed under 35 U.S.C. § 371 (as the present case was not) and that the section of MPEP 803.02 referred to by applicants is not pertinent. If the Examiner is incorrect about this and the term "unity of invention" merely refers to claims

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which are not restrictable (in the instant case restrictable under U.S. practice), it is proper under U.S. practice to restrict species where there is no disclosed relationship between species.

With regard to the newly cited prior art, the previous finality is withdrawn but nonetheless a new FINAL Office action is now issued since the art relied upon was submitted with a 1.17p fee, note MPEP § 609 in this regard.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

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ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

February 10, 2004

JEFFREY C. MULLIS
PRIMARY EXAMINER
GROUP 1200

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